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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant:	Mark D. Scott, et al.	Examiner:	R. Hayes
Serial No.	09/323,765	Group Art Unit:	1647
Filed:	June 1, 1999	Docket No.	259.006US1
Title:	ANTIGENIC MODULATION OF CELLS		

OFFICE OF PETITIONS
MAIL STOP PETITIONS
P.O. BOX 1450
COMMISSIONER FOR PATENTS
Alexandria, VA 22313-145

PETITION TO REVIVE AN UNAVOIDABLY ABANDONED APPLICATION UNDER 37 C.F.R. 1.137(a) OR AN UNINTENTIONALABANDONMENT UNDER 37 CFR 1.137(b)

Attention:
Paralegal Specialist
Office of Petitions
MAIL STOP PETITIONS
P.O. BOX 1450
COMMISSIONER FOR PATENTS
Alexandria, VA 22313-145

Dear Sir/Madam:

FACTUAL BACKGROUND

1) A notice on form PTO-90C was mailed by the U.S. Patent and Trademark Office on January 24, 2003, dismissing the Appeal. It is asserted that this Appeal was untimely dismissed as any difficulty in attempting to respond to the original statement from the PTO mailed on August 29, 2002 (asserting a Non-Compliant Brief) was due at least in part to the lack of clarity as to reasons for failure in compliance of the Brief under 37 CFR 1.192(c).

2) Attorney for Applicant signed the transmittal documents for the Supplemental Brief on Appeal on 23 September 2003, and provided a transmittal cover sheet for transmittal of the documents, authorized payment of the necessary fees in a separate document, and included a return postcard identifying all of these documents.

3) All documents described in paragraph 2) above were mailed with a certification of mailing under 37 C.F.R. 1.8 with a mailing date of 23 September 2003.

4) The return postcard was returned to Attorney for Applicants with a date of receipt in the U.S. Patent and Trademark Office of September 30, 2002 which date is consistent with the mailing date of mailing of the documents identified in paragraph 2..

5) On 24 January 2003, the U.S. Patent and Trademark Office mailed a PTO-90C form on the Application, indicating that Applicant failed to file a Brief in compliance with the original Notice of Non-Compliance.

6) As the documents included with this Petition clearly shows that all formalities for Brief on Appeal of this Application were timely performed *in good faith* by Attorney for Applicants and timely received by the U.S. Patent and Trademark Office, the Abandonment of this Application is clearly in error, was inadvertent and/or unintentional, **and was the result of error on the part of the U.S. Patent and Trademark Office, with no error or responsibility by Applicants or their counsel. AT A MINIMUM, APPLICANTS, ACCORDING TO STANDARD PRACTICE OF THE U.S.P.T.O. SHOULD HAVE BEEN GRANTED TIME TO CORRECT DEFICIENCIES.**

7) Applicants have carefully reviewed the file, especially the final Office Action and the Notice of Non-Compliant Brief and still cannot find **at least some of** the errors that are asserted to exist in the file, as expressed by the Examiner. **SOME OF THE "errors" DO NOT IN FACT EXIST AND THE HOLDING OF THE APPLICATION AS ABANDONED IS CLEARLY IN ERROR AND MUST BE WITHDRAWN.**

8) APPLICANTS herewith submit three copies of what is believed to be a corrected Brief on Appeal and an outline of why the Examiner's position was in error.

9) **LIST OF ERRORS AND RESPONSE**

a) "Appellant failed to correct the issues related to 35 USC 112, 2nd *pp*, and further confuses the issues..."

Appellants either argued the rejections or withdrew the claims so rejected from Appeal. That is at least a showing of a good faith effort to respond. The fact that Appellants argue a rejection rather then submitting to the Examiner's basis for rejection cannot be asserted as error. That is the purpose of an Appeal.

Additionally, the withdrawal of claims from appeal (See Grouping of Claims on pages 11-12, is a legally sufficient response in it own right.

FURTHERMORE, It is not understood how the issues under 35 USC 112, 2d *pp*, identified on paragraph 1 a) of the PTO-90C could be amended since the amendment after final was refused, even though the Advisory Action indicated that amendments, "if later entered," would overcome certain issues under 35 USC 1122, 2d paragraph.

b) Appellant failed to correct state pending claim numbers for the last three issues. Appellant stated the same numbers in the response to an earlier rejection and was unaware of any error. These errors are insignificant, trivial, and purely technical. In accordance with conventional standards of Appeal Practice exercised by the U.S. PTO, these technical errors should have been specifically noted, and Appellants given an opportunity to address them. The holding of the Application as abandoned for a technical error of such minor import is against generally practiced statndards of the U.S. PTO.

In more than ten (10) years of practice under 37 CFR 1.192(c), this is the first instance in over 100 Appeals where an Application has been immediately held abandoned for any technical defect in a Brief without offering Applicants an opportunity to correct such a minor defect. **The standards exercised in the Appeal exceed those commonly used by the PTO and should not be allowed.**

NEW ISSUES

a) The Examiner asserts that "The Brief does not contain a correct copy of claim 9..." Appellants have reviewed the record of this Application. Claim 9 as it appears in the Brief is identical to original claim 9. Claim 9 was never amended during prosecution. Claim 9 in the Brief is believed to be the correct

claim 9 and no reason for this allegation can be found. **This position appears to be completely in error and without foundation.**

b) The Examiner asserts that "The items under 37 CFR 1.192(c) are not in correct order. Counsel for Appellants has used the same order of elements in the Brief for 10 years, and this is the first objection ever raised on that ground. The mere fact that the order of elements in the Brief is in error is hardly a grounds for immediate and summary dismissal of the Appeal and abandonment of the Application.

As noted, a correct copy of the Brief, with the correct order or elements, is provided.

c) The fact that Appellants have grouped claims and the grouping is confusing is not a statutory basis for finding that a grouping has not been made. There is no statutory basis for holding an Appeal dismissed because a grouping is indefinite. The statutes do not even require that a clear grouping be made, but only that a grouping be made. Appellants have "clarified" this grouping in the new Brief, even though the grounds were not sufficient to allow for Dismissal of the Brief.

d) The fact that Appellants have grouped claims and the grouping is confusing is not a statutory basis for finding that a grouping has not been made. There is no statutory basis for holding an Appeal dismissed because a grouping is indefinite. The statutes do not even require that a clear grouping be made, but only that a grouping be made. Appellants have "clarified" this grouping in the new Brief, even though the grounds were not sufficient to allow for Dismissal of the Brief.

ARGUMENTS

As can bne seen from the above discussion, the objections to the Brief were at most formal, technical, insubstantive, erroneous and/or without legal foundation. The Appeal should be reinstated.

PETITION

Appellants Petition as follows:

1) A corrected response (the Brief on Appeal) accompanies this Petition.
2) The original Dismissal of Appeal and holding fo abandonment should be withdrawn as *prima facie* in error and without authority or at least beyond the standard practice of the US PTO. This withdrawal of abandonment, as the fault of the US PTO should be granted under 37 CFR 1.27(a) without charge to the Appellants and the application and Appeal
3) In the event that the Petition is not granted under the grounds outlined in paragraphs 1) and 2) above, the US PTO is respectfully requested to reinstate the Application, with drawn the abandonment, reinstitute the Appeal and accept the Brief in that process under 37 CFR 1.137(b) as an unintentional abandonment.

10) It is the honest belief of Appellants that holding the Appeal dismissed because the record is complex with regard to the status of claims and rejections is inequitable. It is asserted that in equity, the Application should be reinstated, a clear statement of the issues and rejections made on the record, and Appellants should be allowed to respond to a clear statement of the issues.

11) It is believed a hardship and a burden to have the application found abandoned because of the mere difficulty in responding to a record of rejections that cannot be understood (by way of form and not by way of substance) after repeated review of the record.

Applicants, through their Attorney of Record, hereby petition to have the Application issued as a U.S. Patent, and to have the Abandonment with drawn.

IF ANY FEE IS DEEMED NECESSARY, APPLICANTS HEREBY AUTHORIZE SUCH FEE TO BE DEBITED AGAINST ATTORNEY'S DEPOSIT ACCOUNT NO. 50-1391.

IN THE EVENT THAT THE PETITION ON THE ABOVE GROUNDS IS REFUSED, APPLICANT HEREBY PETITIONS TO HAVE THE APPLICATION REVIVED AS UNINTENTIONALLY ABANDONED, THE APPLICATION REIACTIVATED, AND ANY FEES NECESSARY FOR REVIVAL OF THE APPLICATION BE CHARGED TO ATTORNEY'S DEPOSIT ACCOUNT NO. 50-1391. THE BRIEF ON APPEAL SHOULD THEN BE CONSIDERED AS AN AMENDMENT IN RESPONSE TO THE PREVIOUS ACTIONS. **THE EXAMINER IS THEN REQUESTED TO PROVIDE A SINGLE STATEMENT OF THE EXISTING, NON-FINAL REJECTIONS TO WHICH THE APPLICANT CAN THEN RESPOND.**

Applicants hereby petition to revive the application due to the fact that any failure in compliance was unintentional and due to the lack of clear statements on the record as to the existing rejections and claims specifically rejected under the various statutes. The abandonment of the application was unintentional and/or inadvertent, and was at least partially the responsibility of the U.S. Patent and Trademark Office.

The contact person is invited to telephone Applicant's attorney (952) 832-9090 if necessary. **If necessary please charge any additional fees to Deposit Account No. 50-1391 for the petition for revive unintentional abandonment under 37 CFR 1.137(b).**

Respectfully submitted,

Mark D. Scott et al.

By their Representatives,

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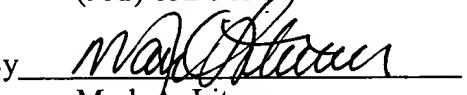
Date: July 24, **2003**

By 

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I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail in an envelope addressed to MAIL STOP PETITION, P.O. BOX 1450, Commissioner for Patents, Alexnadria, VA 22313-1450 on 24 July 2003.

Mark A. Litman
Name


Signature